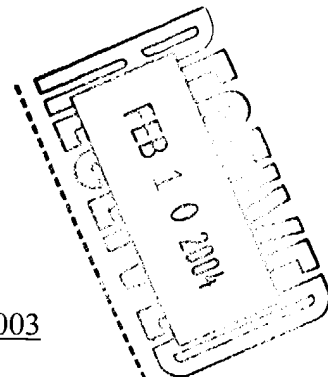


1632

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lynn B. Lunsford et al. Art Unit : 1632
Serial No. : 09/909,460 Examiner : D. Nguyen
Filed : July 18, 2001
Title : MICROPARTICLES FOR DELIVERY OF NUCLEIC ACID

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



REPLY TO OFFICE ACTION DATED DECEMBER 11, 2003

In reply to the Office Action dated December 11, 2003, applicants submit the following remarks.

In the Office Action, the Examiner asserted that applicants' response filed on July 30, 2003, canceled all claims drawn to the elected invention and presented only claims drawn to a non-elected invention.

Applicants respectfully submit that all of the currently pending claims are directed to the elected invention.

Claims 1 and 8 are the independent claims currently pending in the application. Both of these claims were amended in the response filed on July 30, 2003, to require that the claimed microparticle not comprise a liposome or a cell. Claims 1 and 8 are addressed separately, below.

The amendment to claim 8 added a further limitation to the claim. However, the previously pending version of claim 8 did *not* contain a limitation requiring that the microparticle not be encapsulated in a liposome. Applicants submit that merely adding a limitation to the claimed microparticle (i.e., narrowing the claim) did not result in an invention that is independent from that of original claim 8.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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The amendment to claim 1 both limited the claim (by requiring that the claimed microparticle not comprise a liposome) and broadened the claim (by removing the requirement that the microparticle not be encapsulated in a liposome). However, the broadening aspect of the amendment did not result in an invention that is independent from that of previously pending claim 1. The mere fact of broadening a claim in a response to the office action does not in itself imply that applicants have altered the claim so fundamentally as to claim an independent invention.

The microparticles of amended claims 1 and 8 are both directed to microparticles that are less than about 20 microns in diameter and contain a polymeric matrix, a lipid, and a nucleic acid molecule. A requirement that the microparticle not be encapsulated in a liposome is not and has not been during previous prosecution a common feature of these claims. Consistent with these comments, the Restriction Requirement dated October 2, 2002, stated that original claims 1-36 constituted a single restriction group and were "drawn to a polymeric composition comprising a polymer microparticle and DNA, wherein the polymer microparticle is less than about 20 microns. . ." This restriction group (which applicants elected) included some claims (e.g., claim 1) that required that the microparticle not be encapsulated in a liposome as well as some claims (e.g., claim 8) that had no such requirement for the claimed microparticle. For these reasons, applicants submit that not being encapsulated in a liposome is not a required feature of the microparticles of the elected restriction group and that the amendments to the claims did not alter the claims to such an extent to result in a claimed invention that is independent from that that was originally elected.

In light of these comments, applicants respectfully submit that all of the currently pending claims are directed to the elected invention and therefore request that all of the claims be examined.

Applicant : Lynn B. Lunsford et al.
Serial No. : 09/909,460
Filed : July 18, 2001
Page : 3 of 3

Attorney's Docket No.: 08191-014002

Please apply any charges or credits to deposit account 06-1050, referencing Attorney
Docket No. 08191-014002.

Respectfully submitted,

Date: January 12, 2004

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